



**UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/860,007	08/04/97	RALF BERSCHIED, ET AL.	62-209-45694

EXAMINER	
<b>SHIPPEN</b>	
ART UNIT	PAPER NO.
<b>1621</b>	<b>24</b>

DATE MAILED: 10/4/00

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

***Reply Brief***

The reply brief of Paper No. 22, filed July 17, 2000, has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

***Advisory as to Newly Presented Evidence***

The evidence filed in Paper No. 23, (There is no cover letter accompanying this paper. The first sheet refers to "Results of Screening Biocidal Alcohols") filed July 17, 2000, in the form of newly cited references and data will not be considered. Appellants have not shown good and sufficient reasons why it was not earlier presented, 37 C.F.R. § 1.195. Accordingly, the evidence has not been considered further as to its sufficiency, has not been considered for the purposes of appellants' appeal, and is not before the

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Board of Patent Appeals and Interferences. Any arguments based upon the evidence of Paper No. 23 are considered not be substantiated and have been given no weight.

Once an appeal of a final rejection has been made in an application, appellants have no right to further prosecution or consideration of additional evidence in an application, 37 C.F.R. § 1.195. One of the controlling reasons for making an action final is that an issue has been reached and addressed by both the appellants and the Office and should be resolved on the basis of the evidence presented in the application at that point in time unless there are good and sufficient reasons for consideration of additional evidence. The policy of the Office is designed to encourage both the examiner and appellants to present evidence which is material to the patentability of the claims in the application at the earliest point in the examination process as feasible. While the luxury of piecemeal prosecution may be desirable from appellants' point of view, it very clearly does not contribute to the efficient administration of the Patent Office or effective administration of the patent system. Appellants have not submitted any compelling reasons for consideration of the evidence after appeal and have offered no valid reasons why the evidence could not have been submitted until now after the Examiner's Answer.


As to presentation of factual evidence, appellants had complete freedom in responding to rejections made by an examiner. An applicant can respond with arguments alone, amendments and arguments, or amendments coupled with arguments and additional evidence. A showing of facts is but one way which an applicant may choose to

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rebut arguments made by the examiner - this is not a choice the examiner can or should make for an applicant. However, once a choice is made not to present such evidence for the purpose of responding to an Office action, appellants have lost the opportunity to make persuasive argument that the evidence could not have been earlier presented. The fact that the examiner found appellants' mere arguments or previous evidence lacking is not a basis for filing the additional evidence at this time. The responsibility lies not with the examiner but rather was a choice on part of appellants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(703) 308-4635**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1235**. The official group FAX machine number is **(703) 308-4556**.

MShippen  
September 24, 2000

  
**MICHAEL L. SHIPPEN**  
**PRIMARY EXAMINER**  
**ART UNIT 1621**